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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,553	12/18/2001	Audrey A. Sherman	56009 US002	2489

7590 01/29/2003

Attention: Scott R. Pribnow
Office of Intellectual Property Counsel
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EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 01/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,553

Applicant(s)

SHERMAN ET AL.

Examiner

Christopher M. Keehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Specification***

The disclosure is objected to because of the following: The specification does not provide a specific definition of a transient processing aid and a permanent processing aid. There are examples of both set forth but no clear delineation between the two. The definition provided by Applicant for a transient processing aid is that being volatile, and that substantially none of the processing aid remains in the adhesive composition after coating out of a solvent and removal of the solvent. A definition for a permanent processing aid is that of a plasticizer, and that some or all of the processing aid remains in the adhesive composition after coating out of a solvent and removal of the solvent. Because there is no clear example of a transient processing aid, it appears that a variety of processing aids can be transient as defined by Applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-18, 32, 33, 36, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al. (6,107,222). Joseph et al. disclose a pressure sensitive adhesive (psa) comprising a silicone tackifying resin (col.12, line 42-col.13, line 67), a polydiorganosiloxane polyurea copolymer (col.10, line 26-col.12, line 41), and

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a plasticizer that can be blended into the composition (col.14, lines 15-25). Although Joseph et al. do not appear to specifically disclose wherein the silicone tackifying resin and polydiorganosiloxane polyurea copolymer are generally uniformly distributed, Joseph et al. do disclose adding a plasticizer by blending into the composition. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have achieved a generally uniform distribution as instantly claimed because the materials and process of Joseph et al. are the same as instantly claimed, and at least similar materials would have been expected to yield at least similar results.

Regarding claims 2 and 3, Joseph et al. disclose the instantly claimed amounts (col.14, lines 1-12).

Regarding claims 4-6, Joseph et al. disclose adding a plasticizer from the groups as instantly claimed (col.5, lines 47-53) to an adhesive that can be combined in mixture with the polydiorganosiloxane polyurea copolymer (col.4, lines 49-col.5, line 6).

Regarding claim 7, Joseph et al. disclose an additive selected from the group as instantly claimed (col.14, lines 14-20).

Regarding claim 8, Joseph et al. disclose adding the instantly claimed amount of plasticizer (col.14, lines 21-24).

Regarding claim 10, Joseph et al. disclose a polydiorganosiloxane polyurea copolymer that is the reaction product of a polydiorganosiloxane polyamine with a polyisocyanate (col.9, line 57-col.10, line 25).

Regarding claim 11, it appears that Joseph et al. do not specifically disclose a chain extender. However, it is the Examiner's position that chain extenders are known

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and used in the art to control the molecular weight of polymers. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added a chain extender to the composition of Joseph et al. because chain extenders can control the molecular weight of a polymer resulting in a more versatile composition.

Regarding claim 12, Joseph et al. disclose a polydiorganosiloxane polydiamine (col.9, lines 61-62).

Regarding claims 13 and 14, Joseph et al. disclose the instantly claimed polydiorganosiloxane polyurea copolymer repeating unit (col.10, line 26-col.11, line 21).

Regarding claims 15-17, Joseph et al. disclose the instantly claimed limitations (col.11, lines 18-21).

Regarding claim 18, the same reasoning as set forth above for claims 1 and 2 also applies to claim 18, as the claimed subject matter is essentially the same.

Regarding claims 32 and 33, Joseph et al. disclose the psa of claim 1 disposed on a backing, and an article that is capable of being a transfer tape (col.16, lines 25-40).

Regarding claim 36, the same reasoning as set forth above for claim 1 also applies to claim 36, as the claimed subject matter is essentially the same.

Regarding claim 40, Joseph et al. disclose wherein the processing aid is a plasticizer, which Applicant has defined as permanent (col.14, lines 14-20).

Regarding claim 41, Joseph et al. disclose a processing aid selected from the group as instantly claimed (col.14, lines 14-20).

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Claims 1-3, 7-23, 27-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman et al. (WO 96/34028). Sherman et al. disclose a pressure sensitive adhesive (psa) comprising a silicone tackifying resin (page 18, line 25-page 20, line 13), a polydiorganosiloxane polyurea copolymer (page 10, line 9-col.13, line 7), and a plasticizer that can be blended into the composition (page 9, lines 21-23).

Although Sherman et al. do not appear to specifically disclose wherein the silicone tackifying resin and polydiorganosiloxane polyurea copolymer are generally uniformly distributed, Sherman et al. do disclose that the plasticizer can be added at any point in the processing, such as when blending the polydiorganosiloxane copolymer and the silicone resin (page 8, lines 15-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have achieved a generally uniform distribution as instantly claimed because the materials and process of Sherman et al. are the same as instantly claimed, and at least similar materials would have been expected to yield at least similar results.

Regarding claims 2 and 3, Sherman et al. disclose the instantly claimed amounts (col.14, lines 1-12).

Regarding claim 7, Sherman et al. disclose a processing aid selected from the group as instantly claimed (page 9, lines 21-23).

Regarding claim 8, although Sherman et al. do not appear to specifically disclose adding at least 0.5% by weight of processing aid, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added the processing aid of Sherman et al. in an amount included in the range as instantly claimed because

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Applicant is claiming such a broad range, virtually 0% to 100% by weight, and adding any kind of processing aid would appear to be included in the instantly claimed range.

Regarding claim 9, Sherman et al. disclose a solvent-based composition (page 8, lines 9-19).

Regarding claim 10, Sherman et al. disclose a reaction product of a polydiorganosiloxane with a polyisocyanate (page 14, line 5-page 16, line 25).

Regarding claim 11, Sherman et al. do not appear to specifically disclose a chain extender. However, it is the Examiner's position that chain extenders are commonly used in the art to control the molecular weight of a polymer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added a chain extender to control the molecular weight of the polymer.

Regarding claim 12, Sherman et al. disclose polydiorganosiloxane diamine (page 14, lines 4-7).

Regarding claims 13 and 15-17, Sherman et al. disclose the instantly claimed repeating unit (page 10, line 9-page 13, line 3).

Regarding claim 14, Regarding claim 11, Sherman et al. disclose the instantly claimed limitation (page 11, lines 6-10).

Regarding claim 18, the same reasoning as set forth above for claim 1 above (103 with Sherman et al.) also applies to claim 18, as the claimed subject matter is essentially the same.

Regarding claim 19, the same reasoning as set forth above for claims 1 and 9 (103 with Sherman et al.) also applies to claim 19, as the claimed subject matter is essentially the same.

Regarding claim 20, Sherman et al. disclose adding a plasticizer, considered by Applicant to be a permanent processing aid (page 9, lines 21-23).

Regarding claim 21, Sherman et al. disclose adding a variety of processing aids (page 9, lines 21-23). Although Sherman et al. do not appear to specifically disclose a transient processing aid, because it is not clear what is exactly a transient processing aid, as there is no clear example of a transient processing aid, it appears that a variety of processing aids can be transient as defined by Applicant. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added a transient processing aid in the composition of Sherman et al. because it appears that transient processing aids can be a variety of compounds, such as those in Sherman et al.

Regarding claims 22 and 23, Sherman et al. disclose the instantly claimed amounts (page 20, lines 14-21).

Regarding claim 27, Sherman et al. disclose a processing aid selected from the group as instantly claimed (page 9, lines 21-23).

Regarding claim 28, although Sherman et al. do not appear to specifically disclose adding at least 0.5% by weight of processing aid, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added the processing aid of Sherman et al. in an amount included in the range as instantly claimed

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because Applicant is claiming such a broad range, virtually 0% to 100% by weight, and adding any kind of processing aid would appear to be included in the instantly claimed range.

Regarding claim 29, Sherman et al. disclose the instantly claimed polydiorganosiloxane polyurea copolymer repeating unit (page 10, line 9-page 13, line 7).

Regarding claims 30-35, Sherman et al. disclose the psa of claim 1 and the instantly claimed limitations (page 30, line 26-page 31, line 30).

Regarding claim 36, the same reasoning as set forth above for claim 1 (103 with Sherman et al.) also applies to claim 36, as the claimed subject matter is essentially the same.

Regarding claim 37, Sherman et al. disclose a solvent based process (page 8, lines 9-20).

Regarding claims 38-40, the same reasoning as set forth above for claims 20 and 21 (103 with Sherman et al.) also applies to claims 38-40, as the claimed subject matter is essentially the same.

Regarding claim 41, Sherman et al. disclose a processing aid selected from the group as instantly claimed (page 9, lines 21-23).

Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman et al. (WO 96/34028) in view of Joseph et al. (6,107,222). Sherman et al. and Joseph et al. are as set forth above and incorporated herein. Sherman et al. do not

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appear to disclose the instantly claimed processing aids. Joseph et al. disclose adding a plasticizer from the groups as instantly claimed (col.5, lines 47-53) to an adhesive that can be combined in mixture with the polydiorganosiloxane polyurea copolymer (col.4, lines 49-col.5, line 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added a processing aid as taught by Joseph et al. in the composition of Sherman et al. because Joseph et al. teach that adding a processing aid as instantly claimed produces a psa with increased tackiness, such as that produced by microsphere adhesives, resulting in a higher quality product.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (703) 305-2778. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

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Christopher Keehan *CK*

January 16, 2003

A handwritten signature in black ink, appearing to read "Robert Dawson". The signature is fluid and cursive, with a long horizontal stroke at the end.

Robert Dawson
Supervisory Patent Examiner
Technology Center 1700